UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte TSUTOMU USHIODA and TSUYOSHI YAHATA

Appeal No. 2004-0770
Application No. 09/795,310

ON BRIEF

Before GARRIS, OWENS, and WALTZ, Administrative Patent Judges.
WALTZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the primary examiner's final rejection of claims 1 through 6, which are the only claims pending in this application. We have jurisdiction pursuant to 35 U.S.C. § 134.

According to appellants, the invention is directed to a polypropylene composition having the advantages of good flexibility and good elastic recovery where the composition comprises (1) from 1 to 99% by weight of elastomeric polypropylene obtained by copolymerizing propylene and an olefin other than propylene in the presence of a specified catalyst and (2) from 1 to 99% by weight of atactic polypropylene (Brief, page 2). Appellants state that

claims 4 and 5 stand or fall with claim 1, while claims 2, 3 and 6 do not stand or fall together (Brief, page 4). Since appellants present reasonably specific, substantive arguments for the separate patentability of claims 2, 3 and 6 (Brief, pages 8-9; Reply Brief, pages 6-7), we consider these claims separately. See 37 CFR § 1.192(c)(7)(2000) and *In re McDaniel,* 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002). Representative independent claim 1 is reproduced below:

1. A polypropylene composition comprising from 1 to 99% by weight of elastomeric polypropylene obtained through (co)polymerization of propylene or propylene and an olefin other than propylene, in the presence of a metallocene catalyst that comprises a metallocene compound, an activator compound and optionally an organaluminum compound, or of a supported metallocene catalyst that comprises the metallocene catalyst supported on a particulate carrier, or of a catalyst that comprises tetraneophyl zirconium supported on alumina, and from 1 to 99% by weight of atactic polypropylene, totaling 100% by weight.

The examiner relies upon Cheng et al. (Cheng), U.S. Patent 6,342,565, issued Jan. 29, 2002 and filed May 12, 2000, as the sole evidentiary basis supporting the rejection on appeal (Answer, page 3). Claims 1-6 stand rejected under 35 U.S.C. § 102(e) as anticipated by Cheng (Answer, page 4). We *affirm* this rejection essentially for the reasons stated in the Answer and those reasons set forth below.

OPINION

A. The Availability of the Cheng Reference

Before discussing the merits of the examiner's rejection, we must first address appellants' argument that Cheng is not entitled to the 35 U.S.C. § 102(e) date of May 13, 1999, and thus is not available as a reference against the claimed subject matter (Brief, pages 9-12; Reply Brief, page 7).

The following facts are not in dispute: (1) the filing date of Cheng is May 12, 2000, the filing date of the non-provisional application; (2) the filing date of the provisional application of Cheng is May 13, 1999; (3) appellants have claimed priority under 35 U.S.C. § 119 to Japanese Application No. 2000-076238, filed Mar. 17, 2000; (4) a certified English translation of this Japanese document has been made of record; (5) the provisional application of Cheng discloses *verbatim* the disclosure and claims of the Cheng non-provisional application and patent; and (6) the Cheng non-provisional application for patent contains a specific reference to the provisional application (Brief, pages 9-10; Answer, page 7; Reply Brief, page 7). There is similarly no dispute that Cheng, in the provisional and non-provisional applications, fulfills the requirements of the first paragraph of 35 U.S.C. § 112 (*id.*). Accordingly, we agree with the examiner that Cheng has fulfilled the requirements of 35 U.S.C. § 111(b)(1999) and 35 U.S.C. §

119(e)(1)(1999) and is entitled to an effective filing date of May 13, 1999 (see the *Manual of Patent Examining Procedure,* § 201.04(b), Rev. 1, Feb. 2003). Therefore we determine that Cheng is available as prior art under 35 U.S.C. § 102(e)(see the final Office action dated Sep. 17, 2002, Paper No. 7, page 2).

Appellants argue that the examiner's analysis is in error and that, on this record, the examiner has not demonstrated that the specification of the provisional application satisfies the requirements of 35 U.S.C. § 112, first paragraph (Brief, page 10). This argument is not persuasive since the examiner has now demonstrated that the specification of the provisional application complies with the requirements of 35 U.S.C. § 112, first paragraph (Answer, page 7). Appellants have not contested the examiner's position (see the Reply Brief, page 7).

Appellants argue that the statutory basis for priority under 35 U.S.C. § 102(e) is not § 119, but is § 120 and the provisional application does not meet the requirements of section 120 (Brief, pages 11-12; Reply Brief, page 7). This argument is not persuasive since § 119(e) was established to provide for a domestic priority system and the provisional application of Cheng meets all the requirements, as discussed above, to provide an effective date of

May 13, 1999. See 35 U.S.C. § 119(e)(1)(1999), 37 CFR § 1.78 and *MPEP* § 201.04(b), especially pages 200-15 and 200-16.

B. The Rejection under 35 U.S.C. § 102(e)

The examiner finds that Cheng discloses a blend of polymers, with the Second Polymer Component (SPC) corresponding to the first polymer of claim 1 on appeal and the First Polymer Component (FPC) corresponding to the second polymer component of claim 1 on appeal (Answer, page 4). The examiner finds that the SPC disclosed by Cheng is described as in the form of a graft or block copolymer in which there are blocks of polypropylene, thus rendering this polymer elastic (*id.*, citing col. 10, ll. 50 *et seq.*). The examiner further finds that Cheng teaches a method of producing the SPC which is the same or substantially similar to appellants' method of manufacture (*id.*, citing col. 11, ll. 23-52; col. 8, ll. 8-23; and Examples 1 and 2). The examiner finds that Cheng discloses the FPC as "mainly amorphous in the undeformed state," interpreted by the examiner as indicating an atactic polypropylene (*id.*, citing col. 5, ll. 44-67). The examiner further finds that Cheng describes an embodiment of the FPC as a copolymer of atactic and isostatic propylene (*id.*, citing col. 7, ll. 44 *et seq.*).

Under section 102, anticipation requires that the prior art reference disclose, either expressly or under the principles of

inherency, every limitation of the claim. *See In re King,* 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986). Implicit in our review of the examiner's anticipation analysis is that the claim must first have been correctly construed to define the scope and meaning of each contested limitation. *See Gechter v. Davidson,* 116 F.3d 1454, 1457, 43 USPQ2d 1030, 1032 (Fed. Cir. 1997).

The examiner has construed claim 1 on appeal as open to include other components such as isotactic polypropylene, as long as the recited components are present in the required percentages (Answer, pages 5-6). Appellants contest this claim construction and argue that the claims are limited by the phrase "totaling 100% by weight" as recited at the end of claim 1 on appeal. Appellants would construe claim 1 on appeal as including only two components which make up 100% of the total polymers (Brief, pages 5 and 6; Reply Brief, page 5), and argue that claim 1 does not include isotactic polypropylene (Brief, page 7; Reply Brief, page 6).

It is undisputed that claim 1 on appeal recites the transitional term "comprising" (Answer, page 5; Reply Brief, page 5). It is well settled that the transitional term "comprising" used in claim language is a "term of art ... which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claims." *Genentech*

Inc. v. Chiron Corp., 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997). *See also Vehicular Techs. v. Titan Wheel Int'l, Inc.*, 212 F.3d 1377, 1383, 54 USPQ2d 1841, 1845 (Fed. Cir. 2000). As noted above, appellants argue that the claimed phrase "totaling 100% by weight" limits the open construction normally given to "comprising" (Reply Brief, page 5). However, the examiner must give this claimed phrase the broadest reasonable meaning in its ordinary usage as understood by one of ordinary skill in the art, taking into account whatever enlightenment afforded by the written description contained in the specification. *See In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).

The phrase "totaling 100% by weight" may be found at least on page 5, last two lines, and page 6, line 17, of the specification. Appellants have not identified any definition of this phrase but teach that the polypropylene composition of the invention comprises elastomeric polypropylene and atactic polypropylene "in a specified ratio" (specification, page 1, lines 8-9, and page 5, lines 11-13). Appellants teach that many types of additives, including "other various synthetic resins," may be incorporated into the inventive composition (specification, paragraph bridging pages 21-22, and page 32, first full paragraph). Appellants have not identified, and we cannot find, any disclosure in the specification that

teaches that other polymers such as isotactic polypropylene should be excluded from the composition of the invention. Accordingly, appellants are in a weak position to argue a narrow claim construction. *Cf. In re Herz,* 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976). Therefore we construe claim 1 on appeal as requiring the recited essential polypropylene components in specified ratios of weight percentage, but open to include other polymers and additives even in major amounts.

Appellants argue that the examiner has not explained how and why the SPC of Cheng reads on the elastomeric polypropylene required by claim 1 (Brief, page 6, citing definitions from Kravchenko et al. and Coates et al.). Appellants argue that the "predominantly crystalline" SPC of Cheng is not elastic merely because it can be made using a metallocene catalyst system (Reply Brief, page 2). These arguments are not persuasive since we determine that the examiner has presented sufficient evidence supporting a reasonable belief that the SPC of Cheng is the same as appellants' claimed elastomeric polypropylene, i.e., Cheng discloses copolymers of propylene and another olefin produced using the same catalyst system as disclosed and claimed by appellants. *See In re Spada,* 911 F.2d 705, 708, 15 USPQ2d 1655, 1657-58 (Fed. Cir. 1990)("... it was reasonable for the PTO to infer that the

polymerization by both Smith and Spada of identical monomers, employing the same or similar polymerization techniques, would produce polymers having the identical composition.").

Appellants also argue that the description in Cheng of the FPC as being "amorphous in the undeformed state" does not describe an atactic polypropylene (Reply Brief, page 3, citing Coates et al.). This argument is not well taken for several reasons. First, Cheng specifically discloses an embodiment of the FPC where atactic polypropylene is included (col. 7, ll. 44-45). Second, appellants disclose that it is believed "that the majority of amorphous polypropylene has an atactic structure." Specification, page 1, ll. 12-15.

Appellants present specific arguments regarding the patentability of claims 2, 3 and 6 (Brief, pages 8-9; Reply Brief, pages 6-7). These arguments are not persuasive. Regarding the limitations of claim 2, we note that Cheng discloses the preparation of both the FPC and the SPC by use of metallocene catalyst systems (e.g., see col. 8, ll. 8-23, and col. 11, l. 33).[1]

[1] We note that claim 2 recites atactic polypropylene prepared by copolymerization of propylene and another olefin. It appears that appellants intended to recite elastomeric polypropylene. This error does not affect the rejection since Cheng discloses metallocene catalysts for either the FPC or SPC.

With regard to the limitation of claim 3, if the identical composition is described by the prior art, it will necessarily have the same properties. Finally, with regard to the limitations of claim 6, appellants have not contested the examiner's finding that the metallocene catalysts of Cheng include the specific catalysts of this claim (Answer, page 4).

In view of the claim construction discussed above, we determine that the examiner has established a *prima facie* case of anticipation in view of the reference evidence. Accordingly, we affirm the examiner's rejection of claims 1-6 under 35 U.S.C. § 102(e) over Cheng.

No time period for taking any subsequent action in connection with this appeal may be extended under 35 CFR § 1.136(a).

AFFIRMED

BRADLEY R. GARRIS Administrative Patent Judge	)
TERRY J. OWENS Administrative Patent Judge	) BOARD OF PATENT APPEALS AND INTERFERENCES
THOMAS A. WALTZ Administrative Patent Judge	)

TAW/jrg

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